



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,900	04/15/2004	Robert A. Stevenson	GREATB-44681	8957

26252 7590 02/03/2005

KELLY BAUERSFELD LOWRY & KELLEY, LLP
6320 CANOGA AVENUE
SUITE 1650
WOODLAND HILLS, CA 91367

EXAMINER

LAYNO, CARL HERNANDZ

ART UNIT PAPER NUMBER

3762

DATE MAILED: 02/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/825,900

Applicant(s)

STEVENSON ET AL.

Examiner

Carl H. Layno

Art Unit

3762

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2004.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-231 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 144-172 is/are allowed.
6) ☒ Claim(s) 1-4, 18, 26, 27, 52, 53, 60-62, 73, 74, 81, 101, 102, 112, 113, 138, 190, 197, 198 and 208 is/are rejected.
7) ☒ Claim(s) See Continuation Sheet is/are objected to.
8) ☒ Claim(s) 173-189 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 15 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/15/2004.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Continuation of Disposition of Claims: Claims objected to are 5-17, 19-25, 28-51, 54-59, 63-72, 75-80, 82-100, 103-111, 114-137, 139-143, 191-207 and 209-231.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-172 and 190-231, drawn to a feedthrough terminal for use in an active implantable medical device, classified in class 607, subclass 37.
 - II. Claims 173-189, drawn to a generic feedthrough terminal assembly, classified in class 361, subclass 302.

2. During a telephone conversation with Scott W. Kelley on January 31, 2005 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-172 and 190-231. Affirmation of this election must be made by applicant in replying to this Office action. Claims 173-189 of Group II are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Priority

4. Acknowledgment is made of applicant's claim for priority filing based upon U.S. Provisional Applications 60/473,228, filed May 23, 2003, and 60/508,426, filed October 2, 2003.

Information Disclosure Statement

5. Acknowledgment is made of applicant's Information Disclosure Statement (PTO-1449) which was received by the Office on April 15, 2004.

Drawings

6. Applicant's formal drawings were received by the Office on April 15, 2004 and have been approved by the Examiner.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-4, 18, 26, 53, 190, 197, 198, and 208 are rejected under 35 U.S.C. 102(b) as being anticipated by Brendel et al '627 (Applicant's Prior Art).

The Brendel et al '627 patent, cited by the Applicant as prior art, describes an internally grounded feedthrough filter capacitor assembly, which appears to recite all of applicant's claimed elements (Figs. 16-17). The assembly includes a conductive ferrule 34,334, which may

Art Unit: 3762

be mounted on the “substrate”/casing of the implantable medical device **52** (Fig. 5, col. 6—lines 65-bottom) and grounded (Fig. 17), and which encloses a feedthrough capacitor **340**, an inductor **364**, and conductive terminal pins **332**, **332**” (col. 9, lines 24-34).

In regard to claims 2 and 197, applicant’s attention is directed to col. 1, lines 18-22.

In regard to claims 3, 4, 53, and 198, the inductor and capacitor are bonded by epoxy fill **336, 366** (Fig. 16, col. 9, lines 28-30).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 27, 52, 60-62, 73, 74, 81, 101, 102, 112, 113, and 138, are rejected under 35 U.S.C. 103(a) as being obvious over Brendel et al ‘627 in view of Brendel et al ‘103 (both Applicant’s Prior Art).

The applied reference has common inventors with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention “by another”; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference

Art Unit: 3762

under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

The Brendel et al '103 patent, cited as prior art by the applicant, describes a feedthrough assembly similar to that described *supra* in the '627 reference. In addition to the use of a single capacitor and inductor in its assembly, the Brendel et al '103 patent appears to show embodiments (Figs. 27, 31, and 33) utilizing two capacitors, and teaches the use of one or more inductors (col. 13, lines 65-67) in differing EMI filter configurations.

To have equipped the Brendel et al '627 feedthrough assembly with two capacitors versus one, or two inductors versus one, would have been an obvious modification to one of ordinary skill in order to provide a separate capacitor and/or inductor for each feedthrough lead in the manner described by the schematic diagram of Brandel et al '103 (Fig. 33).

Allowable Subject Matter

11. Claims 5-17, 19-25, 28-51, 54-59, 63-72, 75-80, 82-100, 103-111, 114-137, 139-143, 191-207, and 209-231 are objected to as being dependent upon a rejected base claim, but would

Art Unit: 3762

be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

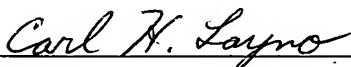
12. Claims 144-172 are allowed.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl H. Layno whose telephone number is (571) 272-4949. The examiner can normally be reached on Monday thru Thursday from 9 AM to 6 PM and every other Friday between 9AM and 5PM. A voice mail or E-mail message (carl.layno@uspto.gov) may be left if desired.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes, can be reached on (571) 272-4955. All faxed correspondence should be sent to the Office's Official FAX number (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Legal Instruments Examiner (LIE) Brenda Webb whose telephone number is (571) 272-4399.



CARL LAYNO
PRIMARY EXAMINER

CHL
2/1/2005